UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER
3622	

29

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.		Applicant(s)	
Office Action Summary	09/451,160		BOAL, STEVEN R.	
	Examiner		Art Unit	
	James W Myhre		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>*29 October 2003*</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-18 and 22-46* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-18 and 22-46* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Response to Arguments

1.   In view of the Appeal Brief filed on October 29, 2003, PROSECUTION IS

HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply

under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied

by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130,

1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.   Claims 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by

Schreiber et al(6,298,446).

        Claim 24: Schreiber disclose a method for distributing and redeeming coupons,

comprising:

              a. associating a Uniform Resource Locator (URL)(i.e. network address)

with a coupon (col 6, lines 37-41 and col 32, line 65 – col 33, line 30);

              b. displaying the coupon to a user (col 6, line 58 – col 7, line 65);

              c. disabling access to the URL by the user (col 6, line 58 – col 7, line 65);

and

              d. invoking (accessing) the URL with a browser to enable the user to

redeem the coupon (col 32, line 65 – col 33, line 30.

        Claim 25: Schreiber disclose a method for distributing and redeeming coupons

as in Claim 24 above, and further discloses selecting the coupon by clicking on the

coupon or other displayed object (col 33, lines 16-30).

3.   Claims 26, 28, 30-32, and 44 are rejected under 35 U.S.C. 102(e) as being

anticipated by Philyaw et al(6,377,986).

Claims 26 and 44: Philyaw discloses a system and method for distributing coupons, comprising:

      a. collecting device information about a client device (col 19, lines 11-60);

      b. associating a device ID with the device information at a main server (col 19, lines 11-60);

      c. selecting a coupon according to the device ID based on the device information (col 19, lines 11-60); and

      d. transmitting the selected coupon to the client system (col 19, lines 11-60).

Claim 28: Philyaw discloses a method for distributing coupons as in Claim 26 above, and further discloses associating the device ID with a remote client system (col 19, lines 11-60).

Claim 30: Philyaw discloses a method for distributing coupons as in Claim 28 above, and further discloses the client system submitting a request including the device ID to the server (col 19, lines 11-60).

Claim 31: Philyaw discloses a method for distributing coupons as in Claim 30 above, and further discloses automatically including the device ID without intervention by the remote user (col 19, lines 11-60).

Claim 32: Philyaw discloses a method for distributing coupons as in Claim 30 above, and further discloses the request is automatically transmitted without intervention by the remote user (col 19, lines 11-60).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-18, 22, and 23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Schreiber et al (6,298,446) in view of Philyaw et al (6,377,986).

6.   Claims 27, 29, 33-43, 45, and 46 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Philyaw et al (6,377,986) in view of Schreiber et al (6,298,446).

The Examiner notes that the claim set contains two inventions. Independent

Claim 24 is directed towards a method of disabling access to a link prior to redeeming a

coupon. Independent Claim 26 is directed towards a method of selecting a targeted

coupon based on the client device's information and ID. Claim 1 and 22 add the

targeting method steps of Claim 26 to the access disabling and redemption steps of

Claim 24. The two inventions are further limited by matching dependent claims. In order

to compress prosecution of the pending claims, the Examiner will group the rejections of

these matching dependent claims together.

The Examiner contends that it would have been obvious to one having ordinary

skill in the art at the time the invention was made to combine the two references. One

would have been motivated to include Philyaw's method of selecting targeted coupons

to Schreiber's method of disabling access to a link prior to redeeming the coupon or to

include Schreiber's method of disabling access to a link prior to redeeming a coupon to Philyaw's method of selecting targeted coupons in order to have a complete coupon processing system in which targeted coupons are selected, issued, and then redeemed by accessing a link which had been disabled.

Claim 1: Schreiber discloses a method for distributing and redeeming coupons as in Claim 24 above, but does not disclose the steps of selecting a targeted coupon based on the device id and information as in Claim 26. However, as discussed above, Philyaw discloses these steps. Therefore, it would have been obvious to include the targeted coupon selection and issuance method of Philyaw with Schreiber's redemption method. One would have been motivated to include the selection and issuance steps in order for Schreiber to have coupons to redeem.

Claim 3: Schreiber and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 1 above, and Philyaw further discloses associating the device ID with a remote client system (col 19, lines 11-60).

Claims 4 and 29: Schreiber and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3 and 28 above, and Schreiber also discloses several methods for printing an unencrypted file (coupon). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the coupon at the client device. One would have been motivated to print the coupon in order to allow the user of the client device to redeem the coupon at a "brick-and-mortar" store.

Claim 5: <u>Schreiber</u> and <u>Philyaw</u> disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 3 above, and <u>Philyaw</u> further discloses the client system submitting a request including the device ID to the server (col 19, lines 11-60).

Claim 6: <u>Schreiber</u> and <u>Philyaw</u> disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 5 above, and <u>Philyaw</u> further discloses automatically including the device ID without intervention by the remote user (col 19, lines 11-60).

Claim 7: <u>Schreiber</u> and <u>Philyaw</u> disclose a method for selecting, distributing, and redeeming targeted coupons as in Claim 5 above, and <u>Philyaw</u> further discloses the request is automatically transmitted without intervention by the remote user (col 19, lines 11-60).

Claims 8 and 33: <u>Schreiber</u> and <u>Philyaw</u> disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 7 and 32 above, and <u>Philyaw</u> further discloses the transmitting step occurs a predetermined intervals (update process)(col 7, lines 51– 65).

Claims 9, 10, 34, and 35: <u>Schreiber</u> and <u>Philyaw</u> discloses a method for selecting, distributing, and redeeming targeted coupons as in Claims 3 and 28 above, but neither reference explicitly discloses that the graphical user interface on the client device uses icons which may also flash to indicate the availability of new coupons. However, the Examiner notes that the use of icons, graphics, colors, animation, etc. to attract the viewer's attention on graphical user interfaces is well known in the computer

arts, and their use would have been obvious to one having ordinary skill in the art at the time the invention was made. One would have been motivated to use icons, flashing or otherwise, to notify the user of the Schreiber and Philyaw systems in order to attract their attention more easily.

Claims 11, 22, and 36: Schreiber and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 3, 24, 26, and 28 above, and Schreiber further discloses encrypting the coupon data at the server prior to sending the coupon to the client system (col 28, 43-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include encryption techniques in the Philyaw system. One would have been motivated to encrypt the coupon data prior to transmitting the data over an unsecure network, such as the Internet as disclosed by Philyaw, in order to prevent unauthorized interception of the data.

Claims 12 and 37: Schreiber and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 11 and 36 above. While neither reference explicitly discloses that the client system will also encrypt the coupon data upon receiving the data from the remote server, Official Notice is taken that it is old and well known to encrypt data using a plurality of encryption methods in order to provide a higher level of security to the data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a local encryption method to further encrypt the encrypted data received from the remote server. One would have been motivated to further encrypt the coupon data locally in

this manner in order to prevent unauthorized disclosure of the selected coupons to other

persons who may use the client device (e.g. other family members, co-workers, etc.).

Claims 13, 23, and 38: Schreiber and Philyaw disclose a method for selecting,

distributing, and redeeming targeted coupons as in Claims 12, 22, and 37 above, and

Schreiber further discloses the client device decrypting and printing the coupon (col 28,

lines 50-52). The Examiner notes that Schreiber discloses several well known methods

for printing unencrypted files (coupons). Thus, once the client system has decrypted

and displayed the coupon data, it would have been obvious that the unencrypted file

could now be printed. Therefore, it would have been obvious to decrypt and print the

coupon being selected by the Philyaw system. One would have been motivated to

decrypt and print the coupon in order to allow the user of the client system to redeem

the coupon at a "brick-and-mortar" store.

Claims 14 and 39: Schreiber and Philyaw disclose a method for selecting,

distributing, and redeeming targeted coupons as in Claims 3 and 28 above. Both

references also disclose displaying at least a portion of the advertisement (coupon) to

the user of the client device (Schreiber, col 28, lines 50-52)(Philyaw, col 19, line 65 – col

20, line 3).

7.   Claims 2 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Schreiber et al (6,298,446) in view of Philyaw et al (6,377,986) as applied to

Claims 1, 14, and 16 above, and in further view of Mankoff (6,385,591).

8.   Claims 27, 40-43, and 45 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Philyaw et al (6,377,986) in view of Schreiber et al (6,298,446) as

applied to Claims 26, 39, 41, and 44 above and in further view of Mankoff (6,385,591).

        Claims 2, 27 and 45: Schreiber and Philyaw disclose a method and system for

selecting, distributing, and redeeming targeted coupons as in Claim 1, 26, and 44

above. While neither reference explicitly discloses obtaining demographic information

including a postal zip code from the user of the client device, Mankoff discloses a similar

system and method for selecting, distributing, and redeeming targeted coupons (col 1,

line 44 – col 2, line 2) which also obtains demographic information, including a postal

zip code, from the user of the client device (col 2, lines 14-18). Therefore, it would have

been obvious to one having ordinary skill in the art at the time the invention was made

to obtain demographic information to include a postal zip code from the user of the

client device in Schreiber or Philyaw. One would have been motivated to obtain this

information in order to allow the systems to better target the selection of the coupon for

redemption at local merchants and to enable the system to mail additional information

(e.g. more coupons or the actual product) to the user.

        Claims 15 and 40: Schreiber and Philyaw disclose a method for selecting,

distributing, and redeeming coupons as in Claims 14 and 39 above, but neither

reference explicitly discloses selecting an advertisement (advertising impression) from a

selected subcategory of coupons. However, Mankoff discloses a similar method for

selecting, distributing, and redeeming target coupons in which the coupons are

arranged in categories and subcategories and the selection of the coupon is based on

the matching category/subcategory (col 4, lines 42-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the available coupons and advertisements in Schreiber and Philyaw in to categories and subcategories and to make the selection from the appropriate category/subcategory. One would have been motivated to sort the advertisements and coupons in this manner in order to facilitate the locating and retrieval of the desired coupons/advertisement.

Claims 16 and 41: Schreiber and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 2 and 28 above, but neither reference explicitly discloses tracking the user's actions on the client device and storing a user history file of such actions. However, Mankoff discloses a similar method for selecting, distributing, and redeeming targeted coupons and further discloses tracking the user's action on the client device and maintaining a database of coupons viewed, selected, and redeemed by the user (col 2, lines 11-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to track and store the user's actions on the client device in Schreiber and Philyaw. One would have been motivated to track the user's actions in this manner in order to allow the advertiser/coupon issuer to better assess the effective of their marketing campaign.

Claims 17 and 42: Schreiber and Philyaw disclose a method for selecting, distributing, and redeeming targeted coupons as in Claims 16 and 41 above, but neither reference explicitly discloses determining the sponsor identification of the displayed advertisement/coupon. However, Mankoff discloses a similar method for selecting,

distributing, and redeeming targeted coupons and further discloses determining the

identity of the advertiser/coupon provider (col 1, lines 55-58 and col 3, lines 55-66).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to determine the identity of the advertiser/coupon issuer in

Schreiber and Philyaw. One would have been motivated to identify the

advertiser/coupon issuer in order to determine to whom the marketing fees would be

charged and to enable the system to provide feedback to the marketer.

Claims 18 and 43: Schreiber, Philyaw, and Mankoff disclose a method for

selecting, distributing, and redeeming targeted coupons as in Claims 16 and 41 above,

and Schreiber discloses encrypting the files prior to transmission across unsecure

network. Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to encrypt the user event (history) files in Philyaw.

One would have been motivated to encrypt this data in order to prevent unauthorized

disclosure to other users of the client device (e.g. family members or co-workers).

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Exr. James W. Myhre whose telephone number is (703)

308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30

p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number

for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be

submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group Receptionist whose telephone number is

(703) 308-1113.

JWM
December 12, 2003

James W. Myhre
Primary Examiner
Art Unit 3622